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By: _____
Daxmara Sanchez

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	David Kunin et al.	**Confirmation No.:**	4941
Serial No.:	09/686,114	**Art Unit No.:**	2611
Filed:	October 11, 2000	**Examiner:**	Bui, Kieu Oanh T.

Title: "METHOD AND APPARATUS FOR INTERNET TV"

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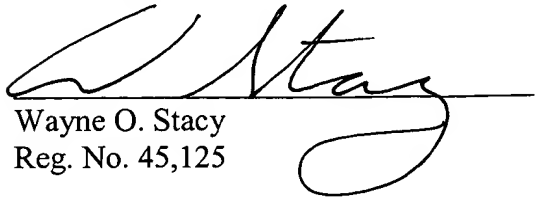
By: 

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Attorney Docket No. ECBL-001201US **PATENT**

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37 C.F.R. § 1.192 APPEAL BRIEF

Sir:

Applicant hereby appeals from the Final Rejection of June 16, 2004 and the Advisory action of November 18, 2004. The Notice of Appeal was filed on December 15, 2004.

I. REAL PARTY IN INTEREST

The assignee, eCable LLC, is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences exist.

III. STATUS OF CLAIMS

Claims 18-40 and 60-64 are pending.

Claims 18-40 and 60-64 stand rejected.

Rejection of claims 18-40 and 60-64 is appealed.

IV. STATUS OF AMENDMENTS

None of the proposed amendments offered subsequent to the final rejection were entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The general public is used to conventional devices such as televisions and phones. Also, the majority of the general public already owns these devices because they are easy to operate and relatively reliable in performance. Therefore, there is a desire for the general public to access/browse the Internet via these conventional devices. Just as many people have quit buying an answering machine and instead use "hardware-less voice messaging services," there is a need to have a "hardware-less" Internet service to access/browse the Internet via televisions and phones. Specification page 3, line 18- page 4, line 3.

Figure 2 of applicants' specification illustrates one embodiment of a system that is constructed in accordance with the principles of the present invention. Other embodiments are disclosed in the specification, covered by the claims, and recognizable by those of skill in the art. But for conciseness as required by the appeal rules, Figure 2 is described with relation to Claim 18. Please note that other systems can perform the functions described in claim 18. A cleaned-up version of applicants' Figure 2 is reproduced below for convenience.

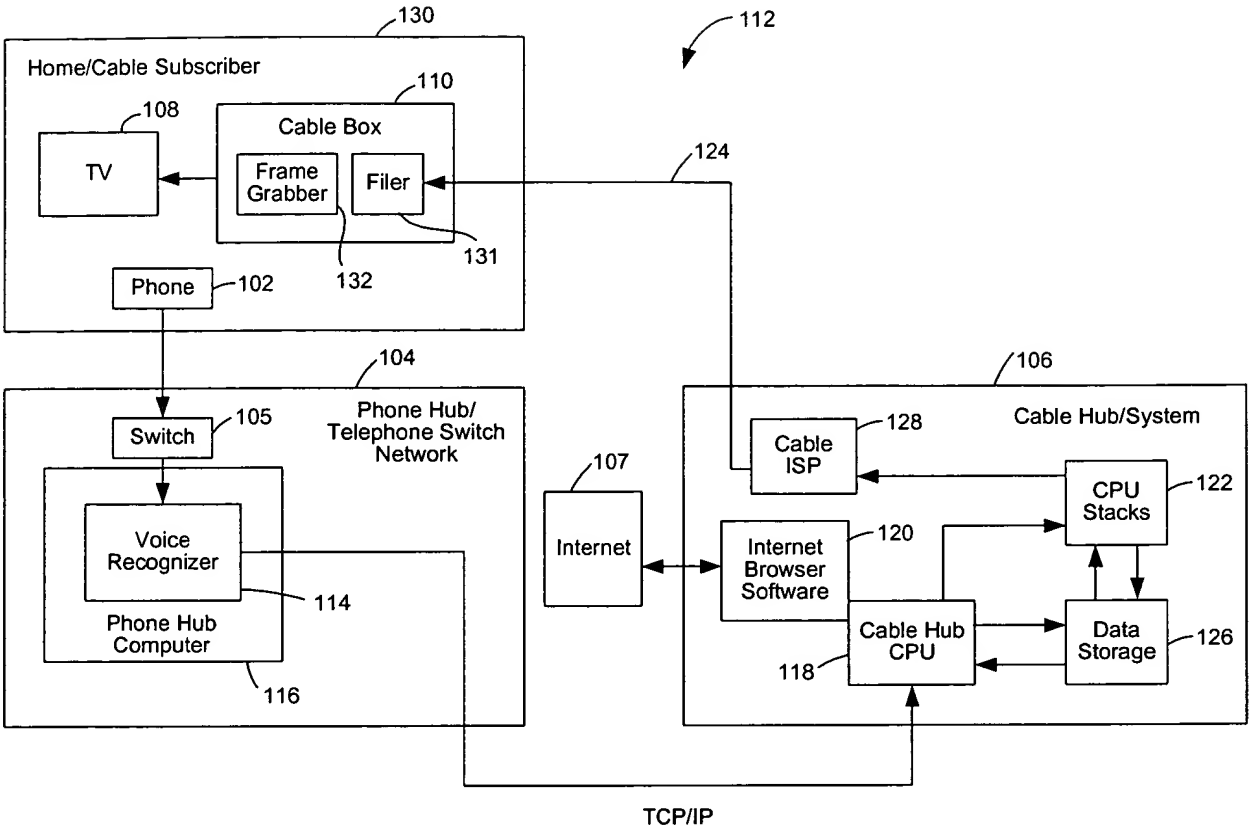

FIG. 2

Claim 18 initially recites the step of "receiving a voice signal transmitted from a user over a phone network, the voice signal including an instruction for browsing the Web." For Figure 2, this step can be performed at the phone hub/telephone switch network 104. The voice signal—including an instruction for browsing the Web—is transmitted from the home/cable subscriber 130—and in particular from the phone 102—to the phone hub/telephone switch network 104. Thus, the voice signal is received over a phone network at the phone hub/telephone switch network 104.

The second step of claim 18 involves "identifying, at a location remote to the user, a Web browsing instruction corresponding to the instruction included in the received voice signal." For

Figure 2, this step can be performed at the phone hub/telephone switch network 104 and in particular at the phone hub computer 116 and the voice recognizer 114.

The next step of claim 18 requires "retrieving data corresponding to the Web browsing instruction." This step can be performed at the cable hub system 106 and in particular at the internet browser software 120.

The final step of claim 18 involves "transmitting the retrieved data to the user over a television network; whereby at least portions of the retrieved data can be displayed on the television system associated with the user." This step can be performed at the cable hub/system 106, and the retrieved data is displayable at the home/cable subscriber system 130. In particular, the retrieved data could be transmitted from the cable ISP 128 to the cable box 110 and displayed on the TV 108.

Other systems or arrangements could perform the functions of claim 18. For example, the phone hub/telephone switch network 104 and the cable hub system 106 could be combined into a single unit. Similarly, the individual portions of the systems could be divided out.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 18 and 22 were properly rejected under 35 U.S.C. 112, second paragraph.

B. Whether claims 18-40 and 60-64 were properly rejected under 35 U.S.C. 103(a).

VII. ARGUMENT

A. Whether claims 18 and 22 were properly rejected under 35 U.S.C. 112, second paragraph.

According to the June 16, 2004 Office Action ("June Office Action"), claims 18 and 22 have "conflicting concepts in the origination of the 'voice signal.'" June Office Action, Page 2.

Applicants respectfully disagree and submit that the two claims are consistent with each other.

First, claim 18 does not address the origination of the voice signal. Instead, claim 18 addresses reception ("receiving") of the voice signal. For example, claim 18 recites "receiving a voice signal transmitted from a user over a phone network, the voice signal including an instruction for browsing the Web." (This step is supported at several places throughout the specification, including Figure 2; page 8, lines 11-15; and page 9, lines 16-20.) Because claim 18 does not address the origins of the voice signal, it cannot conflict with other claims that address the origins of the voice signal.

Claim 22 expressly addresses the origins of the voice signal. For example, claim 22 recites that the "voice signal originates from a set top box associated with the user." This limitation does not change the receiving step of claim 18. Stated differently, claim 22 requires that the voice signal originate from a set top box and claim 18 requires that the voice signal be received over a phone network. For example, the voice signal could originate at the set top box and subsequently be received at the voice recognizer 114. Thus, these two claims together describe that the voice signal originate at a set top box and then is received over a phone network at some other location than the set top box. (This claim is supported at, for example, page 14, lines 5-10 of the specification.)

Claims 18 and 22 are not in conflict. Claim 22 merely defines a further limitation to claim 18. Accordingly, no 35 U.S.C. 112, second paragraph problem exists with these two claims, and the rejection should be withdrawn.

B. Whether claims 18-40 and 60-64 were properly rejected under 35 U.S.C. 103(a).

The rejections against claims 18, 33, 60, 61, 62 should be considered separately. These claims were improperly rejected under 35 U.S.C. 103(a) and contain independent grounds of

allowability. All corresponding dependent claims were also improperly rejected and are allowable because they depend from allowable claims. But for the purposes of this brief, only claims 18, 33, 60, 61, and 62 are individually addressed.

1. Claim 18

Claim 18 stands rejected based on the combination of *Ogasawara* and *Brown*. This rejection is improper for two reasons. First, the combined references fail to teach each limitation of the claimed invention. In particular, the combined references fail to teach the "receiving" limitation. Second, the rejection is improper because the two references cannot be properly combined. In fact, the references teach away from any possible combination–evidencing no motivation to combine.

a. The Combined References Fail to Teach Applicants' Claimed "Receiving" Limitation.

The Examiner cites only *Ogasawara* as disclosing the "receiving" limitation in claim 18. June Office Action, Page 4. Applicant's "receiving" limitation recites "receiving a voice signal transmitted from a user over a phone network, the voice signal including an instruction for browsing the Web." The Examiner points specifically to *Ogasawara* Figure 4, col. 2, lines 19-40; col 3, lines 44-65; and col 4, lines 28-51 in the June Office Action for support. In the November Advisory Action, the Examiner also points to *Ogasawara* column 3, lines 5-65 for support. But none of this material actually teaches the claimed "receiving" limitation. And because the other cited reference, *Brown*, does not cure this flaw in *Ogasawara*, the rejection cannot be properly maintained.

Prior to addressing claim 18, an introduction to *Ogasawara* may be helpful. *Ogasawara* discloses a set top box (STB) 10 that can be configured with voice recognition software to enable Internet shopping. Voice input is recognized by the voice recognition software located at the

STB, and the recognized instructions are transferred from the STB to the Internet shopping program. *Ogasawara*, column 3, lines 29-35. *Ogasawara* also discloses that the STB's remote control unit 14 can act as a cordless telephone or a video phone. *Ogasawara*, column 4, lines 48-51. *Ogasawara*'s Figure 1 illustrates the relevant components and is reproduced below for convenience.

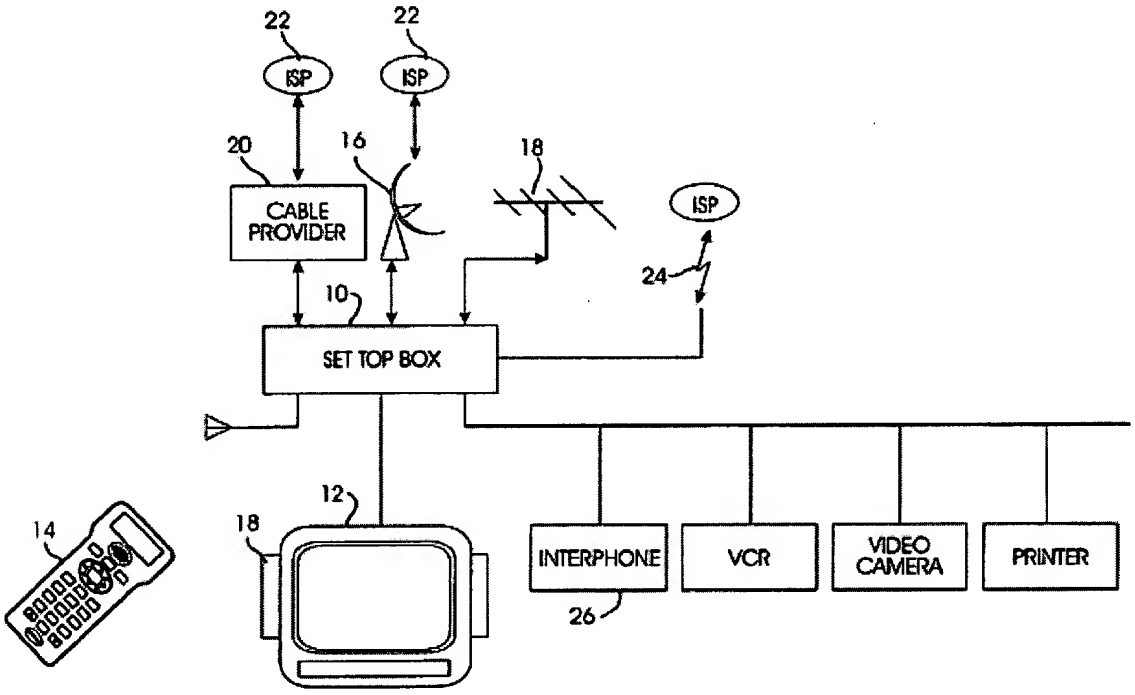

FIG. 1

Referring now to the rejection of claim 18, claim 18 requires "receiving a voice signal transmitted from a user over a phone network, the voice signal including an instruction for browsing the Web." *Ogasawara* does not teach this limitation. And to illustrate this point, three relevant elements described in the cited portions of *Ogasawara* (remote control 14, STB 10, ISP 24) are discussed below. None of these elements can perform the claimed "receiving" step, and no other elements appear relevant or were specifically pointed out by the Office Action.

- Remote control 14: According to *Ogasawara*, the remote control 14 can act as a telephone in certain embodiments. First, *Ogasawara* does not once suggest that the telephone functions of the remote control 14 play any part in Internet shopping or Web browsing. In fact, *Ogasawara* suggests the opposite—that the voice recognition software on the STB plays a part in Internet shopping. The phone acts independent of the Internet functionality and the voice recognition software. *Ogasawara* column 3, lines 14-51. That is, *Ogasawara's* phone is just a phone that happens to be incorporated into a remote control. Moreover, *Ogasawara* does not once mention that the remote control 14 receives any type of instruction for browsing the Web, over a phone network. Thus, the remote control 14 might act as a phone, but it does not receive the claimed voice signal, and Web browsing instruction over a phone network as claim 18 requires.

- Set top box (STB) 10: The STB includes voice recognition software for decoding voice instructions. *Ogasawara*, column 3, lines 29-32. The STB receives these instructions directly from the user and not over a phone network as claim 18 requires. *Ogasawara*, column 3, lines 29-36; column 4, lines 29-36; Figure 4, elements 78, 80, and 86. Thus, the *Ogasawara* STB might receive voice commands, but it does not receive a voice signal over a phone network as claim 18 requires.

- ISP 24: The Internet Service Provider (ISP) 24 does not receive a voice signal that includes an instruction for browsing the Web. *Ogasawara* discloses that a voice command is received directly from the user at the STB 10. *Ogasawara* column 3,

lines 29-32. The STB then uses its voice recognition software to generate an instruction and then transfers the instruction to the ISP. *Ogasawara*, column 3, lines 34-36. Stated differently, *Ogasawara*'s STB 10—through its voice recognition software—converts a voice command into a typical computer instruction and then sends the typical computer instruction to the ISP 24. The ISP 24 may received an instruction, but it does not receive a voice signal that includes an instruction. It instead receives a typical computer signal generated by the voice recognition software at the STB. Accordingly, the *Ogasawara*'s ISP does not receive the voice signal over a phone network as claim 18 requires.

In summary, the June Office Action points to nothing in either *Ogasawara* or *Brown* that teaches the "receiving" step in claim 18. And in particular, nothing in either reference teaches "receiving a voice signal, which includes an instruction for browsing the Web, over a phone network." Accordingly, the rejection against claim 18 is improper and should be withdrawn.

b. *Ogasawara* Cannot be Properly Combined with *Brown* Because *Ogasawara* Teaches Away From The Invention of Claim 18.

Ogasawara discloses a system in which the voice recognition software must reside on the STB at the user's location. See, for example, *Ogasawara* column 3, lines 31-36; column 4, lines 31-38; and Figure 4, elements 78, 80, and 86. Any attempts to move the voice recognition software to a remote location away from the set top box would render the *Ogasawara* device inoperable for its intended purpose. More importantly, any attempts to combine *Ogasawara* with a reference that includes voice recognition software not hosted at the STB would radically and improperly change *Ogasawara's* principle of operation. Id. Accordingly, no proper motivation exists to combine the two references.

C. The Office Action Provides No Proper Motivation for Combining *Ogasawara* and *Brown*.

Even though *Ogasawara* teaches away from systems with remotely-located voice recognition software, the June Office Action proposes to combine *Ogasawara* with *Brown*-a reference that exclusively discloses remotely-located voice recognition software. June Office Action, page 4. In particular, the June Office Action states that *Ogasawara* does not include claim 18's step of "identifying, at a location remote to the user, a Web browsing instruction corresponding to the instruction included in the received voice signal." June Office Action, page 4. And to cure this problem, the Office Action proposes to combine the *Ogasawara* reference with *Brown*, which allegedly teaches a remotely-located interactive voice response system.

The June Office Action provides an alleged motivation for this combination. This alleged motivation is not found anywhere in either reference. Thus, the motivation is improper and the 35 U.S.C. 103 rejection is also improper.

The June Office Action states:

> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Ogasawara*'s system with Brown's detailed technique in using a web-based platform including a voice response system within a remotely web-based platform as discussed in order to handle voice or speech commands from a plurality of users at the system via their handset telephones, which controls the television display and the accessing/browsing the Internet using the web browser. The motivation for doing this is to allow the multiple voices processing of a plurality of users as the users use their telephone for requesting simultaneously services to the system, and the system can effectively handle multiple transactions at the same time to various types of networks as suggested by Brown. June Office Action, page 5.

This alleged motivation to combine is not found in either reference—and *Ogasawara* even teaches away from this combination. Any possible motivation to combine the two references is found only in applicants' specification. In fact, the motivation language cited in the

Office Action appears to come from the applicant's specification rather than from the references. For example, the Office Action's language about allowing "the multiple voices processing of a plurality of users" is not included in either reference, but similar language is found in applicants' specification at page 6, lines 16-18. Accordingly, the cited motivation for combining *Ogasawara* and *Brown* is improperly borrowed from applicants' specification—thus demonstrating impermissible hindsight reconstruction and improper motivation to combine.

In summary, *Ogasawara* and *Brown* cannot be properly combined for two reasons. First, *Ogasawara* expressly teaches away from a system with remotely-located voice recognition software. Any attempts to combine *Ogasawara* with a system that includes remotely-located voice recognition software would render *Ogasawara*'s STB system inoperable for its intended purpose and changes its basic operation. *Ogasawara*, column 1, lines 5-10. And second, even if *Ogasawara* could theoretically be properly combined with *Brown*, which it cannot according to *Ogasawara*'s description, the June Office Action fails to provide any legitimate motivation for combining the two references. In particular, the Office Action fails to point to any material in either reference that justifies the combination. Instead, the Office Action impermissibly borrows motivation language from applicants' specification. Accordingly, the 35 U.S.C. 103 rejection is improper and should be withdrawn.

1. Claim 33

Applicant's claim 33 recites "transmitting the retrieved data to the user over a particular television channel." This claim is rejected based on the combination of *Ogasawara* and *Brown*. And for support, the June Office Action points to *Brown* (apparently to column 4, lines 15-46) and to *Ogasawara* Figures 1-4. First, the cited *Brown* material does not disclose delivering any type of data over a particular television channel. Although *Brown* may disclose the use of a cable network to deliver data, the use of a cable network does not require that data be transmitted

over a particular television channel. Thus, *Brown* does not disclose the television channel limitation of claim 33. Second, the June Office Action fails to point to any material in *Ogasawara* that discloses delivering data over a particular television channel. Again, delivering data over a cable network or to a television is not the same as delivering that data over a particular television channel. Accordingly, the references, whether taken together or individually, do not teach the limitations of claim 33, and the rejection should be withdrawn.

2. Claims 60 and 61

Claims 60 and 61 stand rejected based on the combination of *Ogasawara* and *Brown*. These claims are allowable over these references because *Ogasawara* and *Brown* cannot be properly combined. The impropriety of combining these two references is explained with relation to claim 18, and that explanation is incorporated for claims 60 and 61.

3. Claim 62

Claim 62 stands rejected based on the combination of *Ogasawara* and *Brown*. This claim is allowable for reasons similar to those expressed with regard to claim 18. The discussion of claim 18 regarding the "receiving" limitation is incorporated into the response for claim 62.

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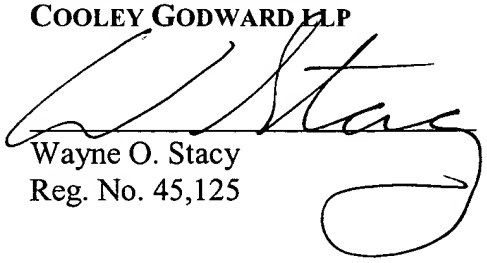
By: 
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CLAIMS APPENDIX

18. A method for viewing data retrieved over the Internet on a television system, the method comprising:

receiving a voice signal transmitted from a user over a phone network, the voice signal including an instruction for browsing the Web;

identifying, at a location remote to the user, a Web browsing instruction corresponding to the instruction included in the received voice signal;

retrieving data corresponding to the Web browsing instruction; and

transmitting the retrieved data to the user over a television network;

whereby at least portions of the retrieved data can be displayed on the television system associated with the user.

19. The method of claim 18, wherein receiving the voice signal transmitted from the user over the phone network comprises:

receiving, at a cable hub, the voice signal transmitted from the user over the phone network.

20. The method of claim 18, wherein receiving the voice signal transmitted from the user over the phone network comprises:

receiving, at a phone hub, the voice signal transmitted from the user over the phone network.

21. The method of claim 18, wherein the voice signal transmitted from the user over the phone network is transmitted over a digital phone network.

22. The method of claim 18, wherein the voice signal originates from a set top box associated with the user.

23. The method of claim 18, wherein identifying the Web browsing instruction corresponding to the received voice signal comprises:

analyzing the voice signal with a natural language representation system.

24. The method of claim 18, wherein retrieving data corresponding to the Web browsing instruction comprises:

sending a request to a Web server for data corresponding to the Web browsing instruction.

25. The method of claim 18, wherein retrieving data corresponding to the Web browsing instruction comprises:

sending a request to a remote Web server for data corresponding to the Web browsing instruction.

26. The method of claim 18, wherein transmitting the retrieved data to the user over the television network comprises:

including a unique identifier with the transmitted data;

wherein the unique identifier is associated with the user and unable to direct the transmitted data to the user.

27. The method of claim 18, wherein transmitting the retrieved data to the user over the television network comprises:

including a unique identifier with the transmitted data;

wherein the unique identifier is associated with a particular set top box.

28. The method of claim 18, wherein transmitting the retrieved data to the user over the television network comprises:

transmitting the retrieved data to a particular set top box over the television network.

29. The method of claim 18, wherein identifying the Web browsing instruction corresponding to the received voice signal comprises:

identifying, at a cable hub, the Web browsing instruction corresponding to the received voice signal.

30. The method of claim 18, wherein identifying the Web browsing instruction corresponding to the received voice signal comprises:

identifying, at a phone hub, the Web browsing instruction corresponding to the received voice signal.

31. The method of claim 18, wherein transmitting the retrieved data to the user over the television network comprises:

transmitting the retrieved data to the user over a satellite television network.

32. The method of claim 18, wherein transmitting the retrieved data to the user over the television network comprises:

transmitting the retrieved data to the user using a digital television network.

33. The method of claim 18, wherein transmitting the retrieved data to the user over the television network comprises:

transmitting the retrieved data to the user over a particular television channel.

34. The method of claim 18, further comprising:

identifying a phone number associated with the origination of the voice signal;

identifying an address associated with the phone number; and

including the address in the transmitted data;

whereby the included address can be used to direct the transmitted data to the user.

35. The method of claim 34; wherein the included address phone number comprises:

is unable to prevent other users from receiving the transmitted data.

36. The method of claim 34, wherein identifying an address associated with the phone number comprises:

identifying an identifier for equipment associated with the user.

37. The method of claim 34, wherein identifying an address associated with the phone number comprises:

identifying a unique identifier for the user.

38. The method of claim 18, wherein the phone network comprises a PSTN.

39. The method of claim 18, wherein the television system comprises a television.

40. The method of claim 38, wherein the television system comprises a cable box.

41 through 59 (withdrawn)

60. A method for viewing data retrieved over the Internet on a television, the method comprising:

receiving a voice signal delivered over a telephone network at a location remote from a user;

identifying a Web browsing instruction corresponding to the received voice signal;

retrieving data corresponding to the Web browsing instruction; and

transmitting the retrieved data to the user over a television network;

whereby the retrieved data can be displayed on the television.

61. A method for viewing data retrieved over the Internet on a television, the method comprising:

receiving a voice signal transmitted from a user over a data transmission network;

identifying, at a location remote to the user, a Web browsing instruction corresponding to the received voice signal;

retrieving data corresponding to the Web browsing instruction; and

transmitting the retrieved data to the user over a television network;

whereby at least portions of the retrieved data can be displayed on the television.

62. The method of claim 61, wherein receiving the voice signal transmitted from the user over the data transmission network comprises:

receiving the voice signal transmitted from a user over a phone network.

63. The method of claim 61, wherein receiving the voice signal transmitted from the user over the transmission network comprises:

receiving the voice signal transmitted from the user over a cable network.

64. The method of claim 50, wherein receiving a voice signal transmitted from a user over a transmission network comprises:

receiving the voice signal transmitted from a user over a satellite network.

EVIDENCE APPENDIX

No Materials.

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